

REMARKS

The issues outstanding in the Office Action mailed November 8, 2006, are the rejections under 35 U.S.C. 112 and 103. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

Rejections Under 35 U.S.C. 112

The Examiner is thanked for indicating the withdrawal of the prior rejections of claims 10 and 14 under 35 U.S.C. 112.

Claims 3, 4, 9-12 and 14-16 are currently rejected under 35 U.S.C. 112, second paragraph. The Examiner's careful reading of the claims is appreciated. Various typographical amendments have been made to the claims, which claims do not change the scope thereof either literally, or for purposes of the doctrine of equivalents. It is submitted that these amendments attend to the issues raised at page 3 of the Office Action. Specifically, the superfluous text in claim 3 has been removed. Clarification between formula I' and I has been made in claim 8, which obviates the rejection of claims 9-12 and 14-16.

Accordingly, withdrawal of all the rejections under 35 U.S.C. 112 is respectfully requested.

Rejections Under 35 U.S.C. 103

Claims 8-12 and 14-16 have been rejected under 35 U.S.C. 103 over Schubert '628. Reconsideration of this rejection is respectfully requested. The Office Action admits, at page 4, that the instant claims differ from the reference by reciting different methods of use. (Indeed, the presently rejected claims are method claims, per se.) However, the Office Action argues that the use of the Schubert estradienes in the methods of claims 8-12 and 14-16 (treating dysfunctional bleeding, dysmenorrhea, inducing amenorrhea, or treating hormonal disorders) would have been obvious in view of other prior art references teaching structurally disparate compounds said to be antigestagens, useful in a variety of utilities. Applicants respectfully disagree with this analysis.

As discussed in the present specification, the present compounds are found to have androgenic action. As a result, they have been found to particularly suitable for treating

dysfunctional bleeding, dysmenorrhea, inducing amenorrhea, or treating hormonal disorders as recited in the claims. Schubert teaches that the compounds therein are useful for birth control, i.e., as antigestagens. Androgenic action is not disclosed in any of the cited secondary references. Accordingly, it is surprising to one of ordinary skill in the art that the compounds recited in the methods are useable in such a manner. Accordingly, withdrawal of the rejection under 35 U.S.C. 103 is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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